



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/379,699	08/24/1999	JEFFRY JOVAN PHIYAW	PHLY-24-747	1610

25883 7590 03/29/2004
HOWISON & ARNOTT, L.L.P
P.O. BOX 741715
DALLAS, TX 75374-1715

EXAMINER

ZIA, SYED

ART UNIT PAPER NUMBER

2131

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/379,699

Applicant(s)

PHIYAW ET AL.

Examiner

Syed Zia

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to amendment filed on January 28, 2004 (Paper No. 16). Original application contained Claims 1-9. Applicant amended Claims 1. Applicant left unchanged Claim 2-9. Therefore, Claims 1-9 are pending for further consideration.

Response to Arguments

1. Applicant's arguments filed January 28, 2004 (Paper No. 16) have been fully considered but they are not persuasive because of the following reasons:

Regarding Claims 1-9 applicant argued that "*the step of connecting is done under the control of the intermediate node and not by a user at the user node or by the any action at the user node... user cannot prevent this from happening ... prevent such connection*"

This is not found persuasive. CPA (Cited Prior Art) [Hudetz et al., US Patent No. 5,978,773] clearly teaches a local computer that is provided with a bar code reader. This reader reads bar codes from products in a standard product code format. The bar code is input to an Internet browser on the computer. The computer accesses a *service provider* and forwards the bar code value to it. The server uses the bar code to access a database. From this is retrieved an Internet address and this is used to connect the computer to that site. The site may have information about the product, or be a site identified by the product. Therefore, in CPA the intermediate node

controls every connection, and the user cannot prevent this from happening, thus intermediate node guarantee the connection accordingly.

As a result, CPA does implement a method for automatic response to the step extracting product code and associating this with network routing to assemble message packet for transmission.

Therefore, the examiner asserts that CPA does teach or suggest the subject matter as recited in independent claims 1. Dependent claims 2-9 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in the this office action (Paper No. 19). Accordingly, rejections for claims 1-9 are respectfully maintained.

Drawings

1. Examiner acknowledges the receipt of drawings dated April 23, 2001. However, the drawings filed on April 23, 2001 were objected and subject to correction of the informalities indicated on the "Notice of Draftsperson's Patent Drawing Review," PTO-948, and mailed to applicant with previous office action (Paper No. 12).

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hudetz et al., US Patent No. (5,978,773).

3. Regarding Claim 1 Hudetz teaches a system and method for using identification codes found on ordinary articles of commerce to access remote computers on a network and comprises a method for utilizing a product code having product information contained therein for interfacing a user node to a remote node over a network, further comprising the steps of

- extracting the product information from the product code at the user node, which product code is disposed on or in close association with an associated product (Fig. 3 and col. 6 line 20 to line 32);

- in response to the step of extracting:

- assembling a message packet containing the product information, transmitting the message packet to an intermediate node on the network, receiving from the intermediate node on the network instructional code that instructs the user node to connect to one of the remote nodes on the network that has defined association with the extracted product information defined at the intermediate node, and connecting the user node to the one of the remote nodes in accordance

with the received instructional code such that connection to the remote location is controlled by the intermediate node through the instructional code, wherein all connections to desired locations are controlled only by the intermediate node and not by any actions at the user node other than the operations of extracting, and wherein actions at the user node do not prevent connection or effect connection to the remote locations (Fig. 3-5 and col. 8 line 33 to 63, and col. 10 line 21 to col.12 line 21).

4. Claims 2- 4 are rejected as applied above in rejecting claim 1. Furthermore Hudetz teaches method of extracting product information wherein

- the product code is machine-readable code (col.5 line 3 to line 5),
- the step of extracting comprises scanning the machine-readable code to extract the product code information (col. 6 line 28 to line 32);
- and machine-readable code comprises a bar code (col. 10 line 12 to line 20).

5. Claims 5-7 are rejected as applied above in rejecting claims 4. Further more Hudetz teaches other formats and system for assigning product identification numbers such as UPC, ISBN and EAN (col. 6 line 34 to line 45).

6. Claims 8 and 9 are rejected as applied above in rejecting claim 1. Furthermore Hudetz teaches a method

- interfacing with the network utilizing network routing information embedded with instructional code (Fig.4-5, col.7 line 2 to col.8 line 10);

- transmitting the message packet comprises the step of:

-transmitting the message packet containing the product code information to the intermediate node on the network (Fig.4 and col.7 line 2 to 16, and col. 8 line 17 to 47 and col. 9 line 14 to line 21);

-comparing the product code information with an associative database having stored therein associations with a plurality of product code information and associated routing information and determining if there is a match (col.8 line 47 to col.9 line 21);

-if there is a match, returning instructional code embedded with the routing information to the location at which the product code information was extracted for assembling into the message packet (col. 8 line 4 to col.8 line 10, col. 10 line 45 to col. 11 line 39).

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2131

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 703-305-3881. The examiner can normally be reached on Monday - Friday 9:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SZ

March 23, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100